



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,557	12/27/2001	Yoshiko Akazawa	1083.1084	9898

21171 7590 06/09/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT PAPER NUMBER

2152

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No.	Applicant(s)	
	10/026,557	AKAZAWA ET AL.	
	Examiner	Art Unit	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 2/2/2006 has been placed of record in the file.
2. Claims 1, 2, 4, 6, and 8-16 have been amended.
3. Claims 1-18 are now pending.
4. The applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the following new grounds of rejection.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 2/28/2006 has been entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1, 2-7, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. The limitation "recipient information" in line 12 of claim 1 (and the similar limitation in claims 2 and 12) is considered indefinite because it is unclear what the limitation is referring to.

It is unclear whether this “recipient information” is the same as or different from the recipient information presented above, making the scope of the claim unclear.

9. Claims 3-7, 13, and 14 are rejected due to their dependence on claims 2 and 12.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 10, 11, 17, and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10, 11, 17, and 18 recite descriptive material that may or may not be an embodiment of a computer system or embodied on a computer readable medium so as to be executable. Here, “a computer memory product” and “computer-readable storage” does not constitute eligible subject matter for patentability. See MPEP 2106.IV.B.1.

12. The applicant’s specification defines the computer program in terms of both statutory and non-statutory embodiments. See the specification, page 25, lines 1-10. The “carrier through a line” embodiment is considered non-statutory as a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. A claim that can be read so broadly as to include statutory and non-statutory subject matter must be amended to limit the claim to a practical application.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-3, 8-12, and 15-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Karaev et al. (U.S. Patent Number 5,802,518), hereinafter referred to as Karaev.

15. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system, a device, an apparatus, or a computer memory product are rejected under the same rationale applied to the described claim.

16. Karaev has disclosed:

- <Claims 1, 2, 8-12, 15, and 16>

An information providing method for providing provision information which is to be provided and registered in a central apparatus in response to a request from plural terminal devices which are connected to said central apparatus by a communication network, comprising the steps of: accepting, by one terminal device, as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient; transmitting, by said one terminal device to said central apparatus, the one set of data after said accepting; registering, in said central apparatus, the one set of data after said transmitting (column 6, lines 21-43); receiving, by said central apparatus, a request and recipient information transmitted from one of terminal

Art Unit: 2152

devices (column 11, lines 19-46); and providing, by said central apparatus to said one of terminal devices which transmitted said request and recipient information, the provision information corresponding to the provision format based on the recipient information registered in the one set of data (column 15, line 60 through column 16, line 7).

- <Claim 3>

The information providing system as set forth in Claim 2, wherein the provision format includes a portable document format which is converted from provision information and an original format which is not converted from provision information (column 3, lines 34-39).

- <Claim 17>

A method for providing requested information to authorized recipients, comprising: storing, as one set of data in computer-readable storage accessible by at least one server, provision information accessible by authorized recipients, recipient information indicating what in the provision information each of the authorized recipients is authorized to receive, and format information corresponding to the provision information and the recipient information indicating in what format the provision information can be provided to each of the authorized recipients (column 6, lines 21-43); receiving, by the at least one server from a requesting terminal device, a request for at least one item of the provision information and a recipient identifier (column 11, lines 19-46); and transmitting, from the at least one server towards the requesting terminal device, requested provision information in a registered provision format if the recipient information indicates that permission to access the requested provision information in the

Art Unit: 2152

registered provision format has been granted to the recipient identifier (column 15, line 60 through column 16, line 7).

- <Claim 18>

A method as recited in claim 17, further comprising: receiving, by the at least one server from a providing terminal device, a provider name for a provider of new provision information (column 6, lines 29-36); and accepting, by the at least one server for storage in the computer-readable storage if the provider name is authorized according to the recipient information, the new provision information, authorized recipient information identifying at least one recipient who is authorized to receive the new provision information, and at least one indication of an authorized format in which the new provision information is to be provided to the at least one recipient (column 6, lines 21-43).

Since all the limitations of the invention as set forth in claims 1-3, 8-12, and 15-18 were disclosed by Karaev, claims 1-3, 8-12, and 15-18 are rejected.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 5, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev, as applied above, in view of D'Angelo (U.S. Patent Number 6,717,938).

Art Unit: 2152

19. Karaev disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, D'Angelo disclosed a communications system that allows users to control what elements of their personal information are available by other users via directory servers.

20. Concerning claims 4 and 13, Karaev did not explicitly state the accepting, transmitting, registering, or providing steps as including name disclosure information as claimed. However, D'Angelo's system allows a user to decide whether or not his name or other personal information is published on a server. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Karaev by adding the ability to include name disclosure information in the one set of data so that the accepting, transmitting, registering, and providing steps included the name disclosure information as provided by D'Angelo. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

21. Thereby, the combination of Karaev and D'Angelo discloses:

- <Claims 4 and 13>

The information providing system as set forth in Claim 2, wherein said processor of said one terminal device is further capable of performing an operation of accepting, as part of the one set of data, name disclosure information indicating whether or not a name of provider who provides the provision information to be disclosed; said operation of transmitting further transmitting the name disclosure information as part of the one set of data; said operation of registering further registering the name disclosure information as

Art Unit: 2152

part of the one set of data; and said operation of providing further providing to the one of said terminal devices which transmitted the request and the accompanying recipient information a name of provider based on the recipient information and the name disclosure information registered in the one set of data (D'Angelo, column 20, lines 3-13).

- <Claim 5>

The information providing system as set forth in Claim 4, wherein the provision format includes a portable document format which is converted from provision information and an original format which is not converted from provision information (Karaev, column 3, lines 34-39).

Since the combination of Karaev and D'Angelo discloses all of the above limitations, claims 4, 5, and 13 are rejected.

22. Claims 6, 7, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev, as applied above, in view of Bhagwat et al. (U.S. Patent Number 6,563,517), hereinafter referred to as Bhagwat.

23. Karaev disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, Bhagwat disclosed methods for transcoding provision information that take into account varying network characteristics.

24. Concerning claims 6 and 14, Karaev did not explicitly state the registering, judging, or providing steps as including auxiliary provision information as claimed. However, Bhagwat's system creates auxiliary provision information to be used depending on the network or network

Art Unit: 2152

characteristics. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Karaev by adding the ability to include auxiliary provision information in the one set of data so that the registering, judging, and providing steps included the auxiliary provision information as provided by Bhagwat. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

25. Thereby, the combination of Karaev and Bhagwat discloses:

- <Claims 6 and 14>

The information providing system as set forth in Claim 2, wherein said operation of registering further registering, as part of the one set of data, auxiliary provision information whose information volume is reduced from said transmitted provision information; said processor of said central apparatus is further capable of performing an operation of judging whether a request from the one of said terminal devices is transmitted through said network or through another network different from said network; and said operation of providing further providing auxiliary provision information, according to the provision format registered in the one set of data, to the one of said terminal devices based on the recipient information registered in the one set of data when it is judged that the one of said terminal devices transmits the request through the other network (Bhagwat, column 5, lines 12-50).

Art Unit: 2152

- <Claim 7>

The information providing system as set forth in Claim 6, wherein the provision format includes a portable document format which is converted from provision information and an original format which is not converted from provision information (Karaev, column 3, lines 34-39).

Since the combination of Karaev and D'Angelo discloses all of the above limitations, claims 6, 7, and 14 are rejected.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Hogan et al. (U.S. Patent Number 5,778,368) disclosed a repository system that utilizes simulation and translational techniques to allow real time embedded software to be re-used, played, and evaluated on various desktop development environments or target operating environments.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

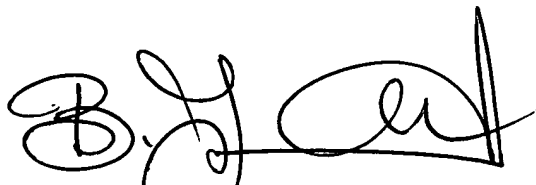
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER